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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,056	03/31/2004	Maria Dalko	239466US0	4868
22850 7590 01/23/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BLAND, LAYLA D	
			ART UNIT	PAPER NUMBER
			1609	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		01/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/813,056

Applicant(s)

DALKO ET AL.

Examiner

Layla Bland

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1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 in part, drawn to a composition comprising a compound of formula (I), where  $n=1$ ,  $R_2=H$ ,  $OH$ , or  $CH_2OH$ ,  $R_1=alkyl$  or  $aryl$  not substituted with any heteroatoms, and  $X$  and  $Y$  are  $NH-alkyl$ ,  $NH_2$ , or  $OH$ , classified in class 541 subclass 459 or 460.
- II. Claims 1-4 in part, drawn to a composition comprising a compound of formula (I), where  $n=1$ ,  $R_2=O-glycoside$ ,  $R_1=alkyl$  or  $aryl$  not substituted with any heteroatoms, and  $X$  and  $Y$  are  $NH-alkyl$ ,  $NH_2$ , or  $OH$ , classified in class 541 subclass 27.
- III. Claims 1-4 in part, drawn to a composition comprising a compound of formula (I), where  $n=0$ ,  $R_2=H$ ,  $OH$ , or  $CH_2OH$ ,  $R_1=alkyl$  or  $aryl$  not substituted with any heteroatoms, and  $X$  and  $Y$  are  $NH-alkyl$ ,  $NH_2$ , or  $OH$ , classified in class 541 subclass 472 or 473.
- IV. Claims 1-4 in part, drawn to a composition comprising a compound of formula (I), where  $n=0$ ,  $R_2=O-glycoside$ ,  $R_1=alkyl$  or  $aryl$  not substituted with any heteroatoms, and  $X$  and  $Y$  are  $NH-alkyl$ ,  $NH_2$ , or  $OH$ , classified in class 541 subclass 27.

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- V. Claims 1-4 in part, drawn to a composition comprising a compound of formula (I), of a structure not included in inventions I-IV, classified in class 514, various subclasses.
- VI. Claims 5-11, 16 and 17 in part, drawn to a composition comprising a compound of formula (II) or (III), where  $R_1$  (or  $R_5$ )= alkyl or aryl not substituted with any heteroatoms, X and Y are NH-alkyl,  $NH_2$ , or OH, and S represents a monosacchride, classified in class 514 subclass 23.
- VII. Claims 5-11, 16 and 17 in part, drawn to a composition comprising a compound of formula (II) or (III), where  $R_1$  (or  $R_5$ )= alkyl or aryl not substituted with any heteroatoms, X and Y are NH-alkyl,  $NH_2$ , or OH, and S represents a polysacchride, classified in class 514 subclass 53, 54, or 61.
- VIII. Claims 5-11, 16, and 17 in part, drawn to a composition of formula (II) or (III) not included in inventions VII and VIII, classified in class 514, various subclasses.
- IX. Claims 12-15, drawn to a cosmetic process comprising a compound of formula (I), where  $n=1$ ,  $R_2=H$ , OH, or  $CH_2OH$ ,  $R_1$ =alkyl or aryl not substituted with any heteroatoms, and X and Y are NH-alkyl,  $NH_2$ , or OH, classified in class 541 subclass 459 or 460, cross-reference subclass 847.
- X. Claims 12-15, drawn to a cosmetic process comprising a compound of formula (I), where  $n=1$ ,  $R_2=O$ -glycoside,  $R_1$ =alkyl or aryl not substituted

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with any heteroatoms, and X and Y are NH-alkyl, NH<sub>2</sub>, or OH, classified in class 541 subclass 27, cross-reference subclass 847.

- XI. Claims 12-15, drawn to a cosmetic process comprising a compound of formula (I), where  $n=0$ ,  $R_2=H, OH, \text{ or } CH_2OH$ ,  $R_1=\text{alkyl or aryl not substituted with any heteroatoms}$ , and X and Y are NH-alkyl, NH<sub>2</sub>, or OH, classified in class 541 subclass 472 or 473, cross-reference subclass 847.
- XII. Claims 12-15, drawn to a cosmetic process comprising a compound of formula (I), where  $n=0$ ,  $R_2=O\text{-glycoside}$ ,  $R_1=\text{alkyl or aryl not substituted with any heteroatoms}$ , and X and Y are NH-alkyl, NH<sub>2</sub>, or OH, classified in class 541 subclass 27, cross-reference subclass 847.
- XIII. Claims 12-15, drawn to a cosmetic process comprising a compound of formula (I), of a structure not included in inventions I-IV, classified in class 514, various subclasses, cross-reference subclass 847.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to compounds of different core structures. Compounds of similar structures are expected to function similarly while compounds of different structures are not. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction

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is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Inventions IX-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to the use of chemical compounds of patentably distinct core structures. Compounds of similar structures are expected to function similarly while compounds of different structures are not. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Inventions I-VIII and IX-XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the cosmetic processes described in inventions IX-XIII can be practiced with another desquamating agent such as salicylic acid, as mentioned in the instant application. Furthermore, the search for a compound or composition is non-coextensive with the search for the use of that compound, as a reference that renders the compound obvious will not necessarily

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render the use of that compound obvious. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**

**in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Election of Species***

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species of a single specific composition comprising a specified individual active compound to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.



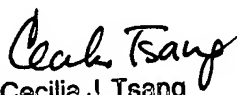
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Bland whose telephone number is (703) 272-9572. The examiner can normally be reached on M-F 7:30AM-5:00PM UST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ldb

  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600